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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,248	02/19/2004	Leslie Orval Hiatt	3682	1419

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EXAMINER

GRAHAM, MARK S

ART UNIT PAPER NUMBER

3711

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/783,248	Applicant(s) HIATT, LESLIE ORVAL	
	Examiner Mark S. Graham	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/19/04</u> . | 6) <input type="checkbox"/> Other: ____. |

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Holly.

Holly discloses the claimed structure and may be used for the same purpose.

Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Dawson.

Dawson discloses the claimed structure and may be used for the same purpose.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over West. West discloses the claimed device with the exception of his pin F being integrally attached and his hoop being integrally formed. However, making West's device completely integral would be merely a matter of obvious engineering choice depending on the degree of portability vs. stability desired by the ordinary skilled artisan. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over West in view of Webster. West (page 1, last 3 lines) discloses that his arch may be varied in shape. It is commonly known in the art to use squared croquet hoops as typified by Webster. In view of Webster it would have been obvious to one of ordinary skill in the art to have used a squared off

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croquet hoop if such a design was preferred by the ordinarily skilled artisan. Concerning the integral limitations and arguments note the discussion of *Larson supra*.

Claims 1-3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spaulding in view of Angell. Spaulding discloses the claimed device with the exception of the use of a pin to attach the marker to the uppermost portion of the hoop. However, such a technique is known in the art as typified by Angell. It would have been obvious to one of ordinary skill in the art to have used the pin and flag technique of Angell if one desired better visibility of the marker. Concerning the integral limitations and arguments note the discussion of *Larson supra*.

Regarding claim 5, the exact length of Angell's pin would obviously have been dependent on the visibility desired by the ordinarily skilled artisan.

Claims 1, 2, and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webster in view of Angell. Webster discloses the claimed device with the exception of the use of a pin to attach a marker to the uppermost portion of the hoop. However, such a technique is known in the art as typified by Angell. It would have been obvious to one of ordinary skill in the art to have used the pin and flag technique of Angell if one desired to use markers in playing the game. Concerning the integral limitations and arguments note the discussion of *Larson supra*.

With regard to claim 6, Angell uses color as his indicia. However, the use of a particular type of indicia is considered to be a choice of printed matter with no new or unobvious structural relationship and therefore is not considered patentable.

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Regarding claim 5, the exact length of Angell's pin would obviously have been dependent on the visibility desired by the ordinarily skilled artisan.

Claims 1, 2, and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webster in view of Chester. Webster discloses the claimed device with the exception of the use of a pin to attach a marker to the uppermost portion of the hoop. However, such a technique is known in the art as typified by Chester. It would have been obvious to one of ordinary skill in the art to have used the pin and flag technique of Chester if one desired to use markers in playing the game. Concerning the integral limitations and arguments note the discussion of *Larson supra*.

Regarding claim 5, the exact length of Chester's pin would obviously have been dependent on the visibility desired by the ordinarily skilled artisan.

With regard to claim 6, Chester uses colored ornamentation as his indicia. However, the use of a particular type of indicia is considered to be a choice of printed matter with no new or unobvious structural relationship and therefore is not considered patentable.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Patent No. D452,543. Although

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the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to the ordinarily skilled artisan that a lawn hoop and a lawn golf game hole marker were the same implement. Regarding claim 5, the exact length of the '543 device would obviously have been up to the ordinarily skilled artisan depending on the visibility desired

Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Patent No. D452,543 in view of Webster. Claim 4 is claimed by the '543 patent with the exception of the squared upper portion. However, as disclosed by Webster it is commonly known in the art to use squared croquet hoops. In view of Webster it would have been obvious to one of ordinary skill in the art to have used a squared off croquet hoop if such a design was preferred by the ordinarily skilled artisan.

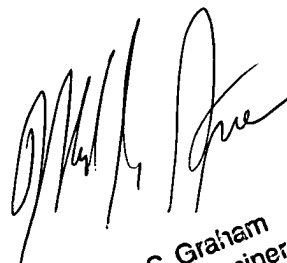
Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Patent No. D452,543 in view of Spaulding. Claim 6 is claimed by the '543 patent with the exception of the numbered marker. However, as disclosed by Spaulding the use of numbered markers is known in the art. In view of Spaulding the use of a particular type of indicia is considered to be an obvious choice of printed matter with no new or unobvious structural relationship and therefore is not considered patentable.

Claims 1-6 are rejected under the doctrine of Res Judicata as claiming the same subject matter found by the Board of Patent Appeals to be unpatentable in claims 7-12 of parent application 09/167,094.

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Any inquiry concerning this communication should be directed to Mark S. Graham at
telephone number 703-308-1355.

MSG
6/21/04



Mark S. Graham
Primary Examiner